

Application Serial No. 10/078,256
Amendment after final Office action dated January 28, 2004
Reply to final Office action of October 28, 2003

REMARKS

Claims 1 through 37 are pending in this application. Claims 1, 2, 3, and 28 are amended herein. Support for the amendments to claims 1, 2, 3, and 28 may be found in the claims and in Figs. 1 through 9 as originally filed. In particular, the phrase "through the first focal point of said first reflector structure" was removed from claims 1, 2, 3, and 28 in order to claim more accurately the various described embodiments of the invention. Reconsideration is requested based on the foregoing amendment and the following remarks.

Objections to the Claims:

Claim 2 was objected to for including claim 1. Claim 1 has consequently been excised from claim 2. Withdrawal of the objection is earnestly solicited.

Claim Rejections - Double Patenting:

Claims 1, 34, and 36 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of Li, US 6,227,682 (Li '682) in view of the Fjaestad et al., US 5,873,646. The rejection is traversed. Reconsideration is earnestly solicited.

Claim 1 recites, in pertinent part:

"a filament lamp."

Neither claims 1 or 2 of Li '682 teach, disclose, or suggest a filament lamp. The final Office action seeks to remedy the deficiencies of claims 1 and 2 of Li '682 by combining claims 1 or 2 of Li '682 with Fjaestad.

The final Office action, however, provides no motivation or suggestion to combine the teachings of claims 1 and 2 of Li '682 with Fjaestad as required by the M.P.E.P. §804, beyond an assertion that persons of ordinary skill in the art at the time of the invention would have modified claims 1 and 2 of Li '682 in this manner "to provide a filament image on the reflectors."

"It is insufficient that the prior art [discloses] the components . . . either separately

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or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. See *In re Rouffet*, 47 USPQ2d at 1457.

If identification of each claimed element in the prior art were sufficient to negate patentability, the final Office action could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. See *Id.* To prevent the use of hindsight based on the teachings of the patent application, the final Office action must show a motivation to combine the references in the manner suggested. See *Id.* at 1457-1458.

Actually, there is no teaching in either claims 1 or 2 of Li '682 or in Fjaestad that would have led persons of ordinary skill in the art at the time of the invention to modify claims 1 or 2 of Li '682 in the manner proposed in the final Office action. Nor does the final Office action describe why persons of ordinary skill in the art would have wanted an image of a filament on a reflector at the time the invention was made.

Claims 1 and 2 of Li '682, in fact, already recite an image source. Claims 1 and 2 of Li '682 are complete in themselves. It is submitted that persons of ordinary skill in the art who read claims 1 and 2 of Li '682 and Fjaestad for all they contained would have seen no reason to modify claims 1 and 2 of Li '682 in the manner proposed in the final Office action. Furthermore, there is no indication in either claims 1 and 2 of Li '682 or Fjaestad that a filament image would have been any improvement over an image source. Claim 1 is thus submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claims 34 and 36 depend from claim 1 and add additional distinguishing elements. With respect to claim 36, the motivation cited in the final Office action is submitted to teach away from the claimed invention. If persons of ordinary skill in the art at the time the invention was made had wanted "to ensure that most of the light is collected by the second reflector portion" they would have made the second reflector portion *larger* than the first reflector portion, not symmetrical with it. Claims 34 and 36 are thus also submitted to be allowable. Withdrawal of the rejection of claims 34 and 36 is earnestly solicited.

Claim 2 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of Li '682 in view of the Fjaestad, and further in view of Strobl, US 5,414,600 (Strobl '600). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 2 depends from claim 1 and adds further distinguishing elements. There is no teaching in either claims 1 or 2 of Li '682 or in Fjaestad that would have led persons of ordinary skill in the art at the time of the invention to modify claims 1 or 2 of Li '682 in the manner proposed in the final Office action, as discussed above with respect to claim 1.

Strobl '600 provides none of the requisite motivation either, and thus cannot make up for the deficiencies of claims 1 and 2 of Li '682 in view of the Fjaestad with respect to claim 2. Claim 2 is thus submitted to be allowable. Withdrawal of the rejection of claim 2 is earnestly solicited.

Claim 4 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of Li '682 in view of the Fjaestad, and further in view of Strobl, US 6,356,700 (Strobl '700). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 4 depends from claim 1 and adds further distinguishing elements. There is no teaching in either claims 1 or 2 of Li '682 or in Fjaestad that would have led persons

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of ordinary skill in the art at the time of the invention to modify claims 1 or 2 of Li '682 in the manner proposed in the final Office action, as discussed above with respect to claim 1.

Strobl '700 provides none of the requisite motivation either, and thus cannot make up for the deficiencies of claims 1 and 2 of Li '682 in view of the Fjaestad with respect to claim 4. There is no reason to believe that claims 1 and 2 of Li '682 needed a higher color temperature to operate more efficiently in the first place, contrary to the assertion in the final Office action. Claim 4 is thus submitted to be allowable.

Withdrawal of the rejection of claim 4 is earnestly solicited.

Claims 5 and 6 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of Li '682 in view of the Fjaestad, and further in view of Dorman, US 4,149,227. The rejection is traversed. Reconsideration is earnestly solicited.

Claims 5 and 6 depend from claim 1 and add further distinguishing elements. There is no teaching in either claims 1 or 2 of Li '682 or in Fjaestad that would have led persons of ordinary skill in the art at the time of the invention to modify claims 1 or 2 of Li '682 in the manner proposed in the final Office action, as discussed above with respect to claim 1.

Dorman provides none of the requisite motivation either, and thus cannot make up for the deficiencies of claims 1 and 2 of Li '682 in view of the Fjaestad with respect to claims 5 and 6. Furthermore, filament lamps generally function better the hotter they are. Persons of ordinary skill in the art at the time the invention was made would have had no reason to apply a coating to dump the infrared spectrum, contrary to the assertion in the final Office action, since to do so would have reduced the efficiency of the proposed combination. Furthermore, the motivation asserted here, namely, "to take the infrared portion of the spectrum out of the light, resulting (in) cool light", is apparently in conflict with the motivation asserted at paragraph 4 of the final Office action with

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respect to the rejection of claim 4, "to achieve a higher color temperature and operate more efficiently." Claims 5 and 6 are thus submitted to be allowable. Withdrawal of the rejection of claims 5 and 6 is earnestly solicited.

Claims 7, 9 and 10 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of Li '682 in view of the Fjaestad, and further in view of Goldenburg et al., US 4,956,759. The rejection is traversed. Reconsideration is earnestly solicited.

Claims 7, 9 and 10 depend from claim 1 and add further distinguishing elements. There is no teaching in either claims 1 or 2 of Li '682 or in Fjaestad that would have led persons of ordinary skill in the art at the time of the invention to modify claims 1 or 2 of Li '682 in the manner proposed in the final Office action, as discussed above with respect to claim 1.

Goldenburg provides none of the requisite motivation either, and thus cannot make up for the deficiencies of claims 1 and 2 of Li '682 in view of the Fjaestad with respect to claims 7, 9 and 10. Claims 1 and 2 already recite a target to be illuminated by the radiation. There is no indication in either claim 1 or claim 2 that persons of ordinary skill in the art at the time the invention was made would have had any reason to transport the radiation anywhere besides the target, contrary to the assertion in the final Office action. Claims 7, 9 and 10 are thus submitted to be allowable. Withdrawal of the rejection of claims 7, 9 and 10 is earnestly solicited.

Claim 8 was rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 2 of Li '682 in view of Fjaestad and Goldenburg, and further in view of Junginger, US 3,772,506. The rejection is traversed. Reconsideration is earnestly solicited.

Claim 8 depends from claim 1 and add further distinguishing elements. There is no teaching in either claims 1 or 2 of Li '682 or in Fjaestad that would have led persons of ordinary skill in the art at the time of the invention to modify claims 1 or 2 of Li '682 in

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the manner proposed in the final Office action, as discussed above with respect to claim 1.

Neither Goldenburg nor Junginger supply the requisite motivation either, and thus cannot make up for the deficiencies of claims 1 and 2 of Li '682 in view of the Fjaestad with respect to claim 8. Furthermore, there is no indication in either claim 1 or claim 2 that persons of ordinary skill in the art at the time the invention was made would have had any reason to conduct the radiation anywhere besides the target, as discussed above with respect to claims 7, 9 and 10, contrary to the assertion in the final Office action. Claim 8 is thus submitted to be allowable. Withdrawal of the rejection of claim 8 is earnestly solicited.

Claims 28, 35, and 37 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 28 of Li, US 6,619,820 (Li '820) in view of Fjaestad. The rejection is traversed. Reconsideration is earnestly solicited.

Claim 28 recites, in pertinent part:

"a filament lamp."

Claim 28 of Li '820 neither teaches, discloses, or suggests a filament lamp. The final Office action seeks to remedy the deficiencies of claim 28 of Li '820 by combining claim 28 of Li '820 with Fjaestad.

The final Office action provides no motivation or suggestion to combine the teachings of claim 28 of Li '820 with Fjaestad as required by the M.P.E.P. §804, beyond an assertion that persons of ordinary skill in the art at the time of the invention would have modified claim 28 of Li '820 in this manner "to provide light and reflect it back to the first reflector structure."

Claim 28 of Li '820, however, already provides light and reflects it back to the first reflector structure. Claim 28 of Li '820 is complete in itself. It is submitted that persons of ordinary skill in the art who read claim 28 of Li '820 and Fjaestad for all they

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contained would have seen no reason to modify claim 28 of Li '820 in the manner proposed in the final Office action. Claim 28 is thus submitted to be allowable. Withdrawal of the rejection of claim 28 is earnestly solicited.

Claims 35 and 37 depend from claim 28 and add additional distinguishing elements. The statement in the final Office action to the effect that paraboloid and symmetrical reflectors are well known is submitted to be conclusory, and does not support a conclusion that the *combinations* of elements recited in claims 35 and 37 are obvious.

Lots of things may be well known individually. Obviousness requires a showing that persons of ordinary skill in the art at the time the invention was made would have been motivated to *combine* the elements recited in claims 35 or 37, not simply that they may have known about them. Claims 35 and 37 are thus also submitted to be allowable. Withdrawal of the rejection of claims 35 and 37 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all claims 1 through 37 are allowable over the cited references. Since the objections to the claims have been addressed, it is submitted that all of claims 1 through 37 are now allowable. Allowance of all claims 1 through 37 and of this entire application are therefore respectfully requested.

Respectfully submitted,

By 

Thomas E. McKiernan

Reg. No. 37,889

Attorney for Applicants

ROTHWELL, FIGG, ERNST & MANBECK

Suite 800, 1425 K Street, N.W.

Washington, D.C. 20005

Telephone: (202)783-6040